UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,583	08/27/2001	Wataru Sasaki	32739M058	2723

7590 11/23/2004	EXAMINER
SMITH, GAMBRELL & RUSSELL, LLP	BRUCKART, BENJAMIN R
Suite 800	

ART UNIT	PAPER NUMBER
2155	

SMITH, GAMBRELL & RUSSELL, LLP
Suite 800
1850 M Street, N.W.
Washington, DC 20036

DATE MAILED: 11/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/938,583	SASAKI ET AL.
	Examiner	Art Unit
	Benjamin R Bruckart	2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 August 2001*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some *   c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date *20030422*.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

Detailed Action

Claims 1-15 are pending in this Office Action.

Information Disclosure Statement

The information disclosure statement filed on 4/22/03 has been considered.

Foreign Priority

Receipt is acknowledged of papers submitted on August 27, 2001 under 35

U.S.C. 119(a)-(d), which papers have been placed of record in the file. Attention is

directed to the fact that the date for which foreign priority is claimed is not the date of the

filed application acknowledged in the oath or declaration. The priority date of August 28,

2000 is given priority.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter, which the applicant regards as his invention.

Claims 1, 10-15 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter

which applicant regards as the invention.

Claims 1, 10, 11, 12, 14 recites the limitation "the surface" and "the original." The

examiner can find no reference to a surface or understand the reference to "an original

set" versus "an original scanner." The diction here is ambiguous as well as the word

original before scanner and set seems to carry no weight. It appears in the first limitation

of the claim and the fifth limitation. There is insufficient antecedent basis for these
limitations in the claims.

Claims 13, 15 recite the limitations "the user" and "the location." There is a lack
of antecedent basis for these claims. The location seems to depend upon claims 12 and 14
which do not define "a location." Claim 12 is rejected for "the location" as well.
Applicant is encouraged to further translate and define in the claims "a location where…."

Claim 15 recites the limitations "the name or the number." There is lack of
antecedent basis for this claim.

Claims 12 and 14 recites the limitation "the same" in the last limitation of the
claim. There is a lack of antecedent basis for these claims as well.

Claim 12 recites the limitations "the operating system" and "the location" which
has a lack of antecedent basis.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the
basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by
another filed in the United States before the invention by the applicant for patent or (2) a patent granted
on an application for patent by another filed in the United States before the invention by the applicant
for patent, except that an international application filed under the treaty defined in section 351(a) shall
have the effects for purposes of this subsection of an application filed in the United States only if the
international application designated the United States and was published under Article 21(2) of such
treaty in the English language.

**Claims 1, 3-5, 9-12, 14 are rejected under 35 U.S.C. 102(e) as being
anticipated by U.S. Patent No. 6,480,884 by Saito.**

Regarding claim 1, a push type scanner apparatus capable of transmitting image data through a network (Saito: col. 2, lines 50-60; col. 3, lines 42-48) comprising:

an original scanner for reading an original set in the push type scanner apparatus and outputting image data of an image on the surface of the original (Saito: col. 2, lines 50-60),

a network connecting interface for connecting the push type scanner apparatus to the network (Saito: col. 5, lines 30-32),

an address specifying means for specifying an address designating a destination for transmitting the image data through the network (Saito: col. 6, lines 1-4),

a mail creating means for creating a mail to be transmitted to the address specified by the address specifying means (Saito: col. 6, lines 26-32),

an appended file creating means for creating, when the original is read by the original scanner, an appended file comprising the image data of the original to be appended to the mail created by the mail creating means (Saito: col. 5, lines 37-57), and

a transmission executing means for outputting the created mail and the appended file through the network connecting interface to the network (Saito: col. 4, lines 56-61)

Regarding claim 3, a push type scanner apparatus as claimed in claim 1, in which the address specifying means includes a means for entering an address to be specified by enter keys (Saito: col. 5, lines 33-37; col. 6, lines 1-4).

Regarding claim 4, a push type scanner apparatus as claimed in claim 1, in which the appended file creating means creates an appended file comprising the image data of the original read by the original scanner, after the address specifying means specifies the address (Saito: col. 5, lines 37-58).

Regarding claim 5, a push type scanner apparatus as claimed in claim 1, further comprising an address book data obtaining means for obtaining address book data from any data processing apparatus connected to the network, in which the address specifying

means specifies a destination address from the address book data obtained by the address book data obtaining means (Saito: col. 5, lines 15-22).

Regarding claim 9, a push type scanner apparatus as claimed in claim 1, further comprising a set expression storing means for storing set expressions used for creating a text writing of a mail (Saito: col. 5, lines 37-58).

Regarding claim 10, a push type scanner apparatus capable of transmitting image data through a network (Saito: col. 2, lines 50-60; col. 3, lines 42-48) comprising

an original scanner for reading an original set therein and outputting image data of an image on the surface of the original (Saito: col. 2, lines 50-60),

a network connecting interface for connecting the push type scanner apparatus to the network (Saito: col. 5, lines 30-32),

a personal computer specifying means for specifying a specific personal computer connected to the network (Saito: col. 6, lines 1-4; Figure 2), and

a transmission executing means for transmitting, when the original is read by the original scanner in association with the personal computer specification executed by the personal computer specifying means, the image data of the original read by the original scanner to the specified personal computer (Saito: col. 6, lines 26- col. 6, line 38).

Regarding claim 11, a push type scanner apparatus capable of transmitting image data through a network (Saito: col. 2, lines 50-60; col. 3, lines 42-48) comprising

an original scanner for reading an original set in the push type scanner apparatus and outputting image data of an image on the surface of the original (Saito: col. 2, lines 50-60),

a network connecting interface for connecting the push type scanner apparatus to the network (Saito: col. 5, lines 30-32),

a destination specifying means for specifying a mail address or a personal computer (Saito: col. 6, lines 1-4),

a first transmission executing means for creating, in response to the mail address specification by the destination specifying means, an appended file comprising the image data of the original read by the original scanner to be appended to a mail, and outputting the created mail and the appended file through the network connecting interface to the network (Saito: col. 5, lines 37-58; col. 6, lines 20-32), and

a second transmission executing means for transmitting, in response to the personal computer specification by the destination specifying means, the image data of the original read by the original scanner to the specified personal computer (Saito: col. 6, lines 27-38).

Regarding claim 12, an image data transmitting and receiving system including a push type scanner apparatus capable of transmitting image data through a network and data processing apparatus connected to the network (Saito: col. 2, lines 50-60; col. 3, lines 42-48), in which the push type scanner apparatus comprises

an original scanner for reading an original set therein and outputting image data of an image on the surface of the original (Saito: col. 2, lines 50-60),

a network connecting interface for connecting the push type scanner apparatus to the network (Saito: col. 5, lines 30-32),

an image data storing folder specifying means for specifying an image data storing folder of a data processing apparatus connected to the network by an address on the network (Saito: col. 5, lines 1-8; secondary storage device of mail server), and

a transmission executing means for transmitting, when the original is read by the original scanner in association with the image data storing folder specification by the image data storing folder specifying means, the image data of the original read by the original scanner to the data processing apparatus (Saito: col. 6, lines 26-38),

the data processing apparatus being provided with an image data receiving software on the operating system, in which the location of the image data storing folder for storing image data is registered (Saito: col. 5, lines 1-8; stores received email),

the image data receiving software being used for receiving the image data transmitted from the scanner apparatus and storing the same in the image data receiving folder (Saito: col. 5, lines 1-8).

Regarding claim 14, an image data transmitting and receiving system including a push type scanner apparatus capable of transmitting image data through a network and a data processing apparatus connected to the network (Saito: col. 2, lines 50-60; col. 3, lines 42-48), in which the push type scanner apparatus comprises

an original scanner for reading an original set therein and outputting image data of an image on the surface of the original (Saito: col. 2, lines 50-60),

a network connecting interface for connecting the push type scanner apparatus to the network (Saito: col. 5, lines 30-32),

an image data storing folder specifying means for specifying an image data storing folder of a data processing apparatus connected to the network by using an address on the network and the name or the number of the image data storing folder (Saito: col. 5, lines 1-8), and

a transmission executing means for transmitting, when the original is read by the original scanner in association with the image data storing folder specification by the image data storing folder specifying means, the image data of the original read by the original scanner to the data processing apparatus (Saito: col. 6, lines 26-38),

the data processing apparatus being provided with an image data receiving software on the operating system, in which the location of the image data storing folder for storing image data is registered (Saito: col. 5, lines 1-8),

the image data receiving software being used for receiving the image data transmitted from the scanner apparatus and storing the same in the image data receiving folder (Saito: col. 5, lines 1-8).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being anticipated by U.S. Patent No. 6,480,884 by Saito in view of U.S. Patent No. 6,374,291 by Ishibashi et al.

Regarding claim 2,

The Saito reference teaches a push type scanner apparatus as claimed in claim 1,

in which addresses and memory are used (Saito: col. 5, lines 15-22).

The Saito reference does note explicitly state selecting a user.

The Ishibashi reference teaches address specifying means specifies an address by

selecting a desired address from a plurality of addresses preliminarily stored in an address

memory (Ishibashi: col. 6, lines 46-65; col. 5, lines 1-7).

The Ishibashi reference further teaches the invention sends a message with image

data scanned is transmitted to the selected user (Ishibashi: col. 5, lines 1-7; 55-60).

Therefore it would have been obvious at the time of the invention to one of

ordinary skill in the art to create an image data transmitting and receiving system as

taught by Saito while employing selecting a user as taught by Ishibashi in order to specify

the party in which the image data scanned is transmitted to (Ishibashi: col. 5, lines 1-7;

55-60).

Claim 6 is rejected under 35 U.S.C. 103(a) as being anticipated by U.S. Patent No. 6,480,884 by Saito in view of U.S. Patent No. 5,893,101 by Balogh et al.

Regarding claim 6,

The Saito reference teaches a push type scanner apparatus as claimed in claim 1, with data input means.

The Saito reference does not teach additional data input means for database processing.

The Balogh reference teaches an additional data inputting means for inputting additional data to be added to image data for database processing (Balogh: col. 3, lines 11-43).

The Balogh reference further teaches the invention allows users to select images using a natural language search capacity (Balogh: col. 1, lines 46-54).

Therefore it would have been obvious at the time of the invention to one of ordinary skill in the art to create an image data transmitting and receiving system as taught by Saito while employing additional data inputting means as taught by Balogh in order to allow users to select and search images using a natural language search (Balogh: col. 1, lines 46-54).

Claims 7-8 are rejected under 35 U.S.C. 103(a) as being anticipated by U.S. Patent No. 6,480,884 by Saito in view of U.S. Patent No. 6,321,267 by Donaldson.

Regarding claim 7,

The Saito reference teaches a push type scanner apparatus as claimed in claim 1, further comprising a store means for storing the destination addresses (Saito: col. 5, lines 19-20).

The Saito reference does not explicitly state limiting transmission based on address.

The Donaldson reference teaches data transmission is limited on the basis of the domain name of each of the said destination addresses (Donaldson: col. 3, lines 34-51), and a transmission limiting means for limiting image data transmission to a destination address by corresponding the domain name of the destination address to the domain names stored in the store means (Donaldson: col. 7, lines 30-40).

The Donaldson reference further teaches the invention filters out security risks and protects resources (Donaldson: col. 7, lines 66- col. 8, lines 6).

Therefore it would have been obvious at the time of the invention to one of

ordinary skill in the art to create an image data transmitting and receiving system as

taught by Saito while employing limiting transmission as taught by Donaldson in order to

filter out security risks and protect resources.

Claim 8 is rejected under the same rationale given above. In the rejections set

fourth, the examiner will address the additional limitations and point to the relevant

teachings of Saito and Donaldson.

Regarding claim 8, a push type scanner apparatus as claimed in claim 1, further

comprising a storing means for storing the destination addresses (Saito: col. 5, lines 19-

20) to which the image data transmission is permitted on the basis of the domain name of

each of the said destination addresses (Donaldson: col. 3, lines 34-51), and a transmission

permitting means for permitting the image data transmission to a destination address by

corresponding the domain name of the destination address to the domain names stored in

the storing means (Donaldson: col. 7, lines 41-50).

**Claims 13, 15 are rejected under 35 U.S.C. 103(a) as being anticipated by
U.S. Patent No. 6,480,884 by Saito in view of U.S. Patent No. 6,374,291 by Ishibashi
et al.**

Regarding claim 13,

The Saito reference teaches an image data transmitting and receiving system as

claimed in claim 12, in which

in each data processing apparatus, the location of the image data storing folder for

storing image data.

The Saito reference does not explicitly state a password with the user.

The Ishibashi reference teaches a password for the image data storing folder set

by the user are registered (Ishibashi: col. 6, lines 34-45),

so that the user selects a folder for storing the image data read by the scanner

apparatus and enters the password set for the selected folder (Ishibashi: col. 6, lines 34-

45), and the scanner apparatus transmits the password entered by the user to the data

processing apparatus having the image data storing folder selected by the user on the basis of an address on the network on the data processing apparatus corresponding to the selected image data storing folder, to query the data processing apparatus whether the password entered by the user coincides with the password registered for the image data storing folder or not (Ishibashi: col. 5, lines 61- col. 6, line 6), and

only when the two passwords coincide with each other, the scanner apparatus scans the image and transmits the image data thereof to the data processing apparatus having the image storing folder (Ishibashi: col. 5, lines 61- col. 6, line 6, lines 35-45).

The Ishibashi reference further teaches the use of a password is to prevent inappropriate use by another person (Ishibashi: col. 6, lines 34-45).

Therefore it would have been obvious at the time of the invention to one of ordinary skill in the art to create an image data transmitting and receiving system as taught by Saito while employing a user password as taught by Ishibashi in order to prevent inappropriate use by another person.

Regarding claim 15,

The Saito reference teaches an image data transmitting and receiving system as claimed in claim 14, in which

in each data processing apparatus, the name or the number and the location of each image data storing folder for storing image data.

The Saito reference does not explicitly state a password with the user.

The Ishibashi reference teaches a password for each image data storing folder set by the user are registered (Ishibashi: col. 6, lines 34-45),

so that the user selects a folder name of the image data storing folder for storing the image data read by the scanner apparatus and enters the password set for the folder corresponding to the selected folder name (Ishibashi: col. 6, lines 34-45), and the scanner apparatus transmits the password entered by the user to the data processing apparatus having the image data storing folder corresponding to the folder name selected by the user on the basis of an address on the network on the data processing apparatus corresponding to the folder name, to query the data processing apparatus having the

image data storing folder corresponding to the folder name whether the password entered by the user coincides with the password registered for the image data storing folder corresponding to the folder name or not (Ishibashi: col. 5, lines 61- col. 6, line 6), and

only when the two passwords coincide with each other, the scanner apparatus scans the image and transmits the image data thereof to the data processing apparatus having the image storing folder corresponding to the folder name (Ishibashi: col. 5, lines 61- col. 6, line 6, lines 35-45).

The Ishibashi reference further teaches the use of a password is to prevent inappropriate use by another person (Ishibashi: col. 6, lines 34-45).

Therefore it would have been obvious at the time of the invention to one of ordinary skill in the art to create an image data transmitting and receiving system as taught by Saito while employing a user password as taught by Ishibashi in order to prevent inappropriate use by another person.

Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

U. S. Patent No. 6,128,101 issued to Saito teaches mailing scanned images with header.

U.S. Patent No. 5,333,266 issued to Boaz teaches collecting and generating messages based on any media type like email.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin R Bruckart whose telephone number 571-272-

3982. The examiner can normally be reached on 8:00-5:30 PM with every other Friday

off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Hosain Alam can be reached on 571-272-3978. The fax phone numbers for

the organization where this application or proceeding is assigned are (703) 872-9306 for

regular communications and After Final communications.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is 571-272-

3982.

Benjamin R Bruckart
Examiner
Art Unit 2155

brb
November 15, 2004

HOSAIN ALAM
SUPERVISORY PATENT EXAMINER